REMARKS

In response to the Office Action dated March 30, 2007, claims 1, 7, 8 and 14 have been amended. Claims 1-20 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action objected to claim 7 due to minor informalities.

In response, the Applicant has amended claim 7 as suggested by the Examiner to overcome this objection.

The Office Action rejected claims 1-20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takagi (U.S. Patent No. 5,486,893) in view of Norita et al. (U.S. Patent No. 6,906,751).

The Applicants respectfully traverse this rejection based on the amendments to the claims and the arguments below.

In particular, the Applicants contend that combined references do not disclose, teach, or suggest all of the elements of the Applicants' newly amended claimed invention. For example, the claims now includes a zoom burst recording mode and plural automatic zoom modes. The automatic zoom modes include near priority mode for automatically recording the images with higher zoom levels, far priority mode for automatically recording the images with low zoom levels, custom wide angle priority for automatically recording the images at different wide angle zoom settings and custom zoom priority mode that has preprogrammed automated zoom capture settings.

In contrast, the combined cited references do not disclose, teach or suggest all of the features of the Applicants' claimed invention, especially in light of the amendments to claims. Specifically, the combined cited references merely disclose a camera having a predicted image display (see col. 1, lines 54-55 and Abstract of Takagi) and a digital camera with a shutter button and a display that displays recorded images (see of Abstract, Summary and FIGS. 1, 4 and 19, and col. 5, lines 42 – col. 6, lines 65 of Norita et al.). Although the combined references disclose predicted images, the predicted images are produced "...by combining a plurality of the resultant photographings known in **advance** based on the different controlling values..." (see col. 1, lines 58-59 of Takagi) [*emphasis added*]. As such,

the combined references are missing elements of the newly amended claims.

Specifically, the combined references are missing the claimed **zoom burst recording mode** and **near priority zoom mode** for automatically recording the images with higher zoom levels, **far priority zoom mode** for automatically recording the images with low zoom levels, **custom wide angle priority** for automatically recording the images at different wide angle zoom settings and **custom zoom priority zoom mode** that has preprogrammed automated zoom capture settings. Instead, the combined references use known "photographings" (see Summary of Takagi) and sequentially capture a plurality of images corresponding to exposure times with respect to a substantially same scene (see col. 2, lines 1-5 and col. 5, lines 42 – col. 6, lines 65 of Norita et al.). However, unlike the combined cited references, the claimed invention uses zoom burst recording mode with plural automatic zoom modes for automatically recording **different zoom levels of an actual scene in real-time**, which is very different from the non-real-time known "photographings" of Takagi and the different exposures of the same scene of Norita et al. Consequently, the combined references do **not** disclose all of the Applicants' newly amended features.

Further, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should **not** be considered together because Takagi teach away from the Applicants' claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Specifically, as argued above, Takagi **explicitly** disclose that "...by combining a plurality of the resultant photographings known in **advance** based on the different controlling values..." (see col. 1, lines 58-59 of Takagi) [*emphasis added*]. Consequently, Takagi teach away because the preview in Takagi is based on photographings known in advance, **unlike** the Applicants' claimed invention which has a zoom burst recording mode with plural automatic zoom modes for recording plural images with different zoom levels of a scene in real-time. As such, the proposed modification or combination would render Takagi being modified unsatisfactory for its intended purpose and would change the principle of operation

of the invention in Takagi being modified if Takagi were **analyzing image scene content** in real-time. In fact, Takagi **cannot** be modified because it is **only** for single reflex cameras (see Abstract and Summary of Takagi) with "photographings known in advance for its preview mode.

Therefore, this "teaching away" prevents this reference from being used by the Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicants' claimed elements of a zoom burst recording mode with plural automatic zoom modes for recording plural images with different zoom levels of a scene in real-time are **not** disclosed, taught or suggested by the combined references and because Takagi **teaches away** from the Applicant's invention, Takagi **cannot** be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. *MPEP 2143.*

Also, the Examiner is reminded that these references **should not** be considered together with the benefit of hindsight. It is well-settled in the law that improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...**the opportunity to judge by hindsight is particularly tempting**. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention or **teaches away** from the Applicant's claimed invention, which is the case here. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001). Since hindsight cannot be used to support the rejections, the combined cited references cannot render the Applicant's invention obvious and the rejection is improper and should be withdrawn. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. Accordingly, this failure of the cited references to disclose, suggest or provide motivation for the Applicant's claimed invention indicates a lack of a prima facie case of obviousness (MPEP 2143).

With regard to the dependent claims, because they depend from the above-argued

respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these claims are also considered to be patentable (MPEP § 2143.03).

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly **request** the Examiner to telephone the Applicants' attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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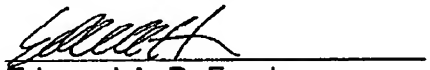
Respectfully submitted,
Dated: July 2, 2007



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